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10-16-01

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UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Application of: VON EICHEL-STREIBEL
Serial No.: 09/581,005
Filed: 6/6/2000
For: TGC METHOD FOR INDUCTING
TARGETED SOMIC TRANSGENESIS
Examiner: Peter Paras, Jr.
Art Unit: 1632

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Response to Restriction Requirement

Assistant Commissioner for Patents
Washington, D.C. 20231

September 25, 2001

Sir:

Applicant hereby respectfully traverses the restriction requirement dated September 17, 2001.

It is respectfully submitted that claims 23 to 51 are directed to a single general inventive concept under PCT Rule 13.1.

In particular, it is respectfully submitted that the Cossart et al. reference (WO 93/152212) does not disclose several features of claim 1, including the fact that "the transcription and the foreign DNA [are] under the control of a eukaryotic regulator gene."

In the Cossart reference, the foreign DNA remain under the control of the bacteria, and thus the present invention is directed to a different general inventive concept. In addition, in the present invention, the episomes delivered by the bacteria are under the control of a eukaryotic cell and then may be eliminated (See feature b.ii.3 of claim 1, for example.) In Cossart the bacteria remain alive and the episomal vector is not under the eukaryotic control.

Method claim 35 and its dependent claims, and claims 48 and 49 are also directed to this general inventive concept where the bacteria carry the foreign DNA in a targeted manner into the tissue of an animal and then the foreign DNA is controlled eukaryotically, which can permit elimination of the bacteria. The method claims are directed to the process by which the bacteria carry the foreign DNA to the tissue or organ of the living animal, where the DNA is controlled

eukaryotically to produce proteins. Claim 48 claims the animal with the eukaryotically controlled foreign DNA, and claim 49 is a further development of the same concept in which the organ or tissue with the eukaryotically controlled DNA is implanted in another.

It is respectfully submitted that all of the pending claims are directed to the same general inventive concept and Cossart does not disclose these features at all.

Withdrawal of the restriction requirement is respectfully requested.

Should the restriction requirement not be withdrawn, Applicants hereby, as required, elect Group I (claims 23-34) to be further examined.

Reconsideration and allowance of the present application is respectfully requested.

Respectfully Submitted,

DAVIDSON, DAVIDSON & KAPPEL, LLC

By: 

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I hereby certify that this document is being deposited with the United States Postal Service as "first class mail" with sufficient postage in an envelope addressed to "Assistant Commissioner for Patents, Washington, D.C. 20231" on September 25, 2001.

DAVIDSON, DAVIDSON & KAPPEL, LLC

BY: Christina Colocotronis
Christina Colocotronis

ASSISTANT COMMISSIONER FOR PATENTS
Washington, DC 20231

In re application of: VON EICHEL-STREIBEL
Serial No.: 09/581,005
Filed: 6/6/2000
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TARGETED SOMIC TRANSGENESIS

Siri

Transmitted herewith is a **RESPONSE TO RESTRICTION REQUIREMENT (2 pgs)** in the above-identified application.

- Small entity status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a verified statement previously submitted.
- A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
- No fee for additional claims is required.

A filing fee for additional claims calculated as shown below, is required:

(Col. 1)		(Col. 2)		SMALL ENTITY		LARGE ENTITY			
FOR:	REMAINING	HIGHEST		RATE	FEES	OR	RATE	FEES	
	AFTER	PREVIOUSLY	PRESENT						
	AMENDMENT	PAID FOR	EXTRA						
TOTAL CLAIMS	* Minus **	=	0	* \$ 10	\$		* \$ 20	\$	
INDEP. CLAIMS	* Minus *	=	0	* \$ 40	\$		* \$ 80	\$	
[] FIRST PRESENTATION OF MULTIPLE DEP. CLAIMS \$ 130							+\$ 260		\$

* If the entry in Co. 1 is less than the entry in Col. 2, write "0" in Col. 3.

** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.

[] Also transmitted herewith are:

Petition for extension under 37 C.F.R. 1.136 (in duplicate)

[] Other:

Check(s) in the amount of \$.00 is/are attached to cover:

Filing fee for additional claims under 37 C.F.R. 1.16

Petition fee for extension under 37 C.F.R. 1.136

[] Other:

[X] The Assistant Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-0552. A duplicate copy of this sheet is enclosed.

Any filing fee under 37 C.F.R. 1.16 for the presentation of additional claims which are not paid by check submitted herewith.

Any patent application processing fees under 37 C.F.R. 1.17.

Any petition fees for extension under 37 C.F.R. 1.136 which are not paid by check submitted herewith, and it is hereby requested that this be a petition for an automatic extension of time

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I hereby certify that this correspondence and/or documents referred to as attached therein and/or fee are being deposited with the United States Postal Service as "first class mail" in an envelope addressed to "Assistant Commissioner for Patents, Washington, D.C. 20231" on September 25, 2001.

September 25, 2001.
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